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FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			QUELER, ADAM M	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,522

Applicant(s)

PARKER, PHILIP M.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. ~~2b) ☒ This action is non-final.~~
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment B and RCE filed on 9/7/2004.
2. Claims 1-58 are pending in the case. Claims 1, 16, 29, 56-58, are independent claims.

Response to Amendment

3. The declaration under 37 CFR 1.132 filed 02/16/2005 is insufficient to overcome the rejection of claims 1-58 based upon insufficiency of disclosure under 35 U.S.C. 112 as set forth in the last Office action because of the reasons stated in the rejection below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 for example recites, "providing an automation program." This program, while mentioned in the specification is never described. It is submitted that one of ordinary skill in the art would have to have to use undue experimentation in order to provide the program that would do it. The specification (p. 20, ll.7-16) generally describes the characteristics of one such program but does not provide any details as to how they work. Applicant's invention allegedly automatically author's books. This does not appear to be a menial task as Applicant admits (Specification, p. 4, ll. 1-2). In fact Applicant admits that some though it would not be done for many years. The crucial parts of the

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invention are these programs and macros that author the material, and they are not disclosed. It seems counter-intuitive that the that program that does most of the work creating something that Applicant alleges no one else could create at the time, could be written without undue experimentation, simply from the disclosure that it can be written in commonly known programming languages.

MPEP 2106.01 provides several guidelines for such as undisclosed “block element.” One of which is that a method that if a method requires a particular apparatus, in this case the program it is axiomatic that the application must therefore provide a sufficient disclosure of that apparatus if such is not already available. See *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971) and *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402, 406 (CCPA 1976). The MPEP suggests as a general guideline to question enablement of a program is the lack of the “program listing or a reasonably detailed flowchart which delineates the sequence of operations the program must perform.” Applicant alleges the figures and the specification (Page 26, Line 22 - Page 27, line 3 and Page 27, Lines 3-4) provide such explanation. However, the figures and the specification generally describe the support structure for the program, and generally treat the program as a “black box” which is executed in concert with the system, but there is never any discussion of how the program works, or how one could provide it.

The affidavit also fails to prove sufficiency of disclosure. It does not appear that the affiant is one of *ordinary* skill in the art. It appears from paragraph 6 that affiant’s job responsibilities include the creation of such programs. Therefore he would naturally be able to write the programs given the specification. However, it still does not provide evidence that some one of ordinary skill in the art could follow the specification as a guideline when the

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specification does not give any indications how this program functions. MPEP 2106.01

describes a similar case:

In re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973), illustrates the extent of the inquiry into the factual basis underlying an affiant's conclusions or opinions. In *Brandstadter*, the invention concerned a stored program controller (computer) programmed to control the storing, retrieving, and forwarding of messages in a communications system. The disclosure consisted of broadly defined block diagrams of the structure of the invention and **no flowcharts or program listings of the programs of the controller**. The Court quoted extensively from the Examiner's Office Actions and Examiner's Answer in its opinion where it was apparent that the Examiner consistently argued that the disclosure was **merely a broad system diagram in the form of labeled block diagrams along with statements of a myriad of desired results**. Various affidavits were presented in which the affiants stated that all or some of the system circuit elements in the block diagrams were either well-known in the art or "could be constructed" by the skilled design engineer, that the controller was "capable of being programmed" to perform the stated functions or results desired, and that the routineer in the art "could design or construct or was able to program" the system. The Court did consider the affiants' statements as being some evidence on the ultimate legal question of enablement but concluded that the statements failed in their purpose since they recited conclusions or opinions with few facts to support or buttress these conclusions. With reference to the lack of a disclosed computer program or even a flowchart of the program to control the message switching system, the record contained no evidence as to the number of programmers needed, the number of man-hours and the level of skill of the programmers to produce the program required to practice the invention.

In this case the essential "block" is this "program" and there is no listing or flowchart of its operation. The Office submits that the program represents a labeled block element, with no disclosure of its operation, only the "desired results."

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 32-33, 51 and 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term “numerous” in claim 55 is a relative term that renders the claim indefinite. The term “numerous” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The terms “small numbers” and “economically viable” in claim 48 are relative terms that render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The scope of this claim is so incredibly broad, that it is impossible for examining purposes to provide proper prior art. Therefore, for examining purposes only, the limitations will not be considered and the claim rejected similarly as its parent claim.

Claims 32-33 and 51 are rejected for claiming a trademark. If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1, 2, 4-30, 32, 34-49, 51, 53-56 and 58 rejected under 35 U.S.C. 102(e) as being anticipated by Clark et al. (US 20020152215A1-filed 9/26/2001).**

Regarding independent claim(s) 1 and 16, Clark discloses authoring an electronic version of book. This authoring is done using a program (para. 86). The book is derived from a file (para. 36). The authoring of the electronic version involves logical manipulation (shown at least in para. 47, 48, 49, and 53). It also includes content not in that file, such as listings of figures and tables, etc. and a table of contents (para. 53).

Regarding independent claim(s) 29, Clark discloses authoring an electronic version of book. This authoring is done using a program (para. 86). The book is derived from a file (para. 36). The authoring of the electronic version involves logical manipulation (shown at least in para. 47, 48, 49, and 53). It also includes content not in that file, such as listings of figures and tables, etc. and a table of contents (para. 53). Clark teaches authoring meta-data (para 57).

Regarding dependent claim(s) 2, Clark teaches distributing the book (para. 68-84).

Regarding dependent claim(s) 4 and 21, Clark teaches two formats (para .53).

Regarding dependent claim(s) 5 and 22, Clark teaches authoring meta-data (para 57).

Regarding dependent claim(s) 6 and 23, Clark teaches distributing meta-data (para. 57).

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Regarding dependent claim(s) 7, 24, and 30, Clark teaches authoring marketing material (para. 57).

Regarding dependent claim(s) 8 and 25, Clark teaches distributing marketing material (para. 57).

Regarding dependent claim(s) 9-10, and 26, the specification defines control materials as including title and meta-material, the distribution and authoring of which have been addressed in the rejection of claims 1-2 and 5-6 above.

Regarding dependent claim(s) 11, anything is capable of the being associated with a unique code, but for the sake of argument, Clark teaches the book is associated with a code (para. 37).

Regarding independent claim(s) 12, Clark teaches the book is associated with a UPC (para. 37).

Regarding dependent claim(s) 13, Clark teaches a book as described in claim 1, and a book is inherently a written publication.

Regarding dependent claim(s) 14, Clark teaches a plurality of books (para. 52), Adobe eBooks, and Microsoft eBooks.

Regarding dependent claim(s) 15, Clark teaches a authoring in response to a request (para. 43).

Regarding dependent claim(s) 17, Clark discloses distributing over a network (para. 26).

Regarding dependent claim(s) 18, Clark discloses selling over a network (para. 24).

Regarding dependent claim(s) 19, Clark discloses the network is the Internet (para. 6).

Regarding dependent claim(s) 20, Clark teaches a book, which is inherently capable of being written in more than one language.

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Regarding dependent claim(s) 27, Clark teaches authoring and distributing meta-data (para 57).

Clark teaches authoring and distributing marketing material (para. 57). Clark teaches control material (para. 53). Clark teaches a purchasing recipient (para. 72).

Regarding dependent claim(s) 28, Clark discloses templates to be used for authoring (para. 53).

Regarding dependent claim(s) 32, Clark discloses Windows (Fig. 5).

Regarding dependent claim(s) 34-45 and 53-54, the titles of the genres are found to be non-functional descriptive data and therefore taught by Clark.

Regarding dependent claim(s) 46, Clark teaches a PC (para. 86).

Regarding dependent claim(s) 47, Clark teaches a microcomputer (para. 86).

Regarding dependent claim(s) 48, in view of the indefinite scope of the claim as described above, the claim is rejected similarly as claim 1 above.

Regarding dependent claim(s) 49, Clark teaches a PDF format (para. 53).

Regarding dependent claim(s) 51, Clark teaches Word (para. 45).

Regarding dependent claim(s) 55, Clark teaches a graphical presentation (para. 48).

Regarding dependent claim(s) 56, Clark discloses authoring an electronic version of book.

This authoring is done using a program (para. 86). The book is derived from a file (para. 36).

The authoring of the electronic version involves logical manipulation (shown at least in para. 47, 48, 49, and 53). It also includes content not in that file, such as listings of figures and tables, etc. and a table of contents (para. 53). Clark teaches a PDF format (para. 53).

Regarding dependent claim(s) 58, Clark discloses authoring an electronic version of book.

This authoring is done using a program (para. 86). The book is derived from a file (para. 36).

The authoring of the electronic version involves logical manipulation (shown at least in para. 47,

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48, 49, and 53). It also includes content not in that file, such as listings of figures and tables, etc. and a table of contents (para. 53). Clark teaches the book is associated with a code (para. 37).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 31, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, and further in view of Kent (US 20020040374A1, filed 9/29/2001).

Regarding dependent claim(s) 3, 31, and 52, Clark does not teach different languages. Kent teaches translating a publication (para. 22), such as an eBook (para. 83). It would have been obvious to author in two different languages in order to expand the market size for the book (para. 22).

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, and further in view of Tidwell, "Why Visual Basic for Applications (VBA) should be in your Curriculum."

Regarding dependent claim(s) 33, Clark does not explicitly disclose Visual Basic for Applications. Tidwell discloses programming in VBA (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to program the program with VBA because it is a powerful development tool (p. 2, Summary).

13. Claims 50 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, and further in view of "ONIX Explained" hereinafter Netread.

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Regarding dependent claim(s) 50, Clark does not teach ONIX. Netread teaches ONIX. It would have been obvious to one of ordinary skill in the art at the time of the invention to use ONIX because it was a known standard (p.1).

Regarding dependent claim(s) 57, Clark discloses authoring an electronic version of book. This authoring is done using a program (para. 86). The book is derived from a file (para. 36). The authoring of the electronic version involves logical manipulation (shown at least in para. 47, 48, 49, and 53). It also includes content not in that file, such as listings of figures and tables, etc. and a table of contents (para. 53). Clark teaches authoring meta-data (para 57). Clark does not teach ONIX. Netread teaches ONIX. It would have been obvious to one of ordinary skill in the art at the time of the invention to use ONIX because it was a known standard (p.1).

Response to Arguments

14. Applicant's arguments with respect to claims 1-58 have been considered but are moot in view of the new ground(s) of rejection.

Arguments relating to the declaration under CFR 1.132 and the §112, 1st paragraph rejection are addressed above.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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